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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/595,480

02/08/2007

Marco Lopez

034166.024

1237

25461 7590 04/23/2010  
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EXAMINER

NGUYEN, CAM N

ART UNIT

PAPER NUMBER

1793

MAIL DATE

DELIVERY MODE

04/23/2010

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/595,480	<b>Applicant(s)</b> LOPEZ ET AL.	
	<b>Examiner</b> Cam N. Nguyen	<b>Art Unit</b> 1793	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period **will** apply and **will** expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply **will**, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01/20/10(an amendment/response).
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 9-30 is/are pending in the application.
- 4a) Of the above claim(s) 21-30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 9-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)         | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### Response to Amendment

1. The amendment filed on 01/20/10 has been made of record and entered. Claims 1-8 have been canceled. Claims 9-13 & 15-20 have been amended.

Claims 9-30 are currently pending in this application.

### Status of Withdrawn Claim(s)

2. **Claims 21-30** are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention(s), there being no allowable generic or linking claim.

Election was made **without** traverse in the reply filed on 04/03/09.

### Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 9-20** are rejected under 35 U.S.C. 103(a) as being unpatentable over Kolb et al., hereinafter referred to as “***Kolb ‘739***”, (US Pat. 3,853,739).

***Kolb ‘739*** discloses an electrode consisting essentially of an electrically conductive substrate, an electrocatalytically active material and an amorphous valve metal oxide binder for adhering said material to at least a portion of the surface of said substrate, the material being a

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particulate solid material of iridium and ruthenium oxides having a particle size of less than 0.1 micron, iridium oxide being present within the range of 1.0-99 mole percent, the balance being ruthenium oxide (see col. 8, claim 1). The substrate is a metal selected from the group consisting of titanium and tantalum (see col. 8, claim 2). The binder is an amorphous oxide selected from the group consisting of tantalum and niobium oxides (see col. 8, claim 3). See also entire reference for further details.

First, while the reference does not specify the surface area and other properties, such as the water solubility, of the binder material (which is the claimed inorganic oxides), it would be obvious and expected that the surface area and water solubility of the disclosed binder material would be the same and the surface area would be at least 50 m<sup>2</sup>/g because the disclosed oxides binder material are the same as the claimed inorganic oxides.

Second, *Kolb '739* does not disclose the amount of the binder material contained in the electrode. However, it would have been *prima facie obvious* to one of ordinary skill in the art at the time the invention was made to have utilized the binder material at the claimed percentage of the inorganic oxide, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art, See *In re Aller*, 105 USPQ 233.

#### *Response to Applicants' Arguments*

4. The remarks filed on 01/20/10 have been fully considered, but not deemed persuasive in view of the new ground of rejection(s) and/or objection(s) above.

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**Citations**

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. All references are cited for related art. See PTO-892 Form prepared attached.

**Conclusion**

6. Claims 9-30 are pending. Claims 9-20 are rejected. Claims 21-30 are withdrawn due to nonelected (distinct) invention(s). No claims are allowed.

**Contacts**

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Primary Examiner CAM N. NGUYEN, whose telephone number is 571-272-1357. The examiner can normally be reached on M-F, 9:00 AM - 6:30 PM, at alternative work site.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stanley Silverman, can be reached on 571-272-1358. The fax phone number for the organization where this application or proceeding is assigned is 571-272-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Cam N. Nguyen/

Primary Examiner

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/C. N. N./

April 21, 2010